PATENT
Attorney Docket No.: 019491-004510US
Client Ref. No.: 45US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of:	Confirmation No. 5097
Leinfellner et al.	Examiner: Gregory J. Vaughn
Application No.: 09/495,622	Technology Center/Art Unit: 2178
Filed: February 1, 2000	SUPPLEMENTAL APPEAL BRIEF UNDER 37 CFR §41.37
For: ELECTRONIC IN-APPLICATION POSTCARDS	
Customer No.: 20350	

Mail Stop Appeal Brief
Commissioner for Patents
Board of Patent Appeals and Interferences
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Appellant hereby submits this supplemental appeal brief pursuant to 37 CFR §41.37 and responsive to the Advisory Action mailed May 17, 2006. The Appeal brief filed on May 5, 2005 has been modified hereby to include all required headings pursuant to 37 CFR 41.37.

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REAL PARTY IN INTEREST:

The real party in interest of the subject patent application is Electronic Arts Inc., the owner of the patent application.

RELATED APPEALS AND INTERFERENCES:

There are no known related appeals, interferences or judicial proceedings which may be related to, directly affect or be directly affected by or have bearing on the Board's decision in the pending appeal.

STATUS OF CLAIMS:

Claims 1-7 and 9-21 are pending. Claims 1-7 and 9-21 stand rejected. Appellants appeal from the rejection of claims 1-7 and 9-21.

STATUS OF AMENDMENTS:

An amendment under 37 CFR 1.116 was filed on April 15, 2005, canceling claim 8 in response to the Examiner's Answer mailed on March 7, 2005. Cancellation of claim 8 has been entered into the record in the Advisory Action mailed May 17, 2006.

SUMMARY OF THE CLAIMED SUBJECT MATTER:

The present invention provides systems and methods for sending an electronic message from within a game application to an intended recipient over a network. The systems and methods of the present invention allow a user to capture a screenshot or other multimedia information during execution of a game application, add messaging information to create a composite message, and send the composite message with the captured screenshot (or other multimedia information) to an intended recipient over a network from within the game application without leaving the executing game environment. In one aspect, an e-mail client is "embedded" in the game application; by incorporating the composite message generation and sending features within the game application itself, a user is able to send composite messages from within the executing game application without exiting the game application or unduly hindering gameplay. The user, in this manner, is able to seamlessly immerse herself into a game world and share an aspect of the game world, such as a screenshot or other multimedia information, with other users on a network without having to leave the game world or unduly disrupt gameplay.

In one embodiment, for example as recited in claim 1, the present invention provides a method of sending an electronic message from within a game application (*e.g.*, column 6, lines 9-12; FIG. 1, element 105) to an intended recipient over a network (*e.g.*, FIG. 1, element 124). Another embodiment, as recited in claim 19, provides a computer readable medium storing instructions for causing a processor to implement a method similar to the method recited in claim 1. This method typically includes receiving a user input selecting an image generated by the game application (*e.g.*, column 7, lines column 10, lines 9-13) and generating a message form from within the game application for receiving message information (*e.g.*, column 7, line22 to column 8, line 4; FIG. 2, element 208). The method also typically includes combining the selected image and the message information into a composite message (*e.g.*, column 8, lines 4-10; FIG. 2, element 212), and sending the composite message from within the game application to the intended recipient over the network (*e.g.*, column 8, line 11 to column 9, line 2; FIG. 2, element 216).

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In another embodiment, for example as recited in claim 9, the present invention provides a method of capturing a gaming experience of a currently executing game application for transmission as a message to a remote recipient (*e.g.*, in FIG 1, over network 124 or to recipient 100(2)). The method typically includes capturing a user selected multimedia information generated as part of the gaming experience (*e.g.*, FIG. 2, element 204; FIG 3, element 308; and column 9, line 18 to column 10, line 24), and receiving text to accompany the multimedia information (*e.g.*, FIG 4a, element 412; column 11, lines 1-7; and column 11, lines 20-23). The method also typically includes creating a composite message using the captured multimedia information and the received text (*e.g.*, FIG. 2, element 212; FIG. 5; and column 12, lines 1-22), and sending the composite message from within the game application to a recipient at a remote location (*e.g.*, FIG. 2, element 216; FIG. 6; and column 14, line 12 to column 15, line 9).

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL:

The issues on appeal are:

Whether claims 1-4, 7, 9-13, 19 and 21 are unpatentable under 35 USC §102(a) as being anticipated by SnagIt software, version 4.3 (hereinafter "SnagIt").

Whether claims 5, 6, 16, 17 and 20 are unpatentable under 35 USC §103(a) as being obvious in view of SnagIt and Snook, US Patent No. 6,400,378.

Whether claims 14 and 15 are unpatentable under 35 USC §103(a) as being obvious in view of SnagIt and Killcommons *et al.*, US Patent No. 6,424,996.

Whether claim 18 is unpatentable under 35 USC §103(a) as being obvious in view of SnagIt and Toyoda, US Patent No. 6,094,277.

ARGUMENT

I.   Rejection under 35 USC §102(a) over SnagIt.

<u>Claims 1-4, 7, 9-13, 19 and 21</u>

Claims 1-4, 7, 19 and 21 are not anticipated by SnagIt. For example, SnagIt fails to teach or suggest the limitation of "sending the composite message from within the game application to the intended recipient over the network" as recited in independent claim 1, or the limitation of "sending the composite message from within the game application to the intended recipient at a remote location" as recited in independent claim 9. Nor does SnagIt teach or suggest the similar limitation of code including instructions for causing a processor to "send the composite message from within the game application to the intended recipient over the network" as is recited in independent claim 19.

In SnagIt, an e-mail client external to an application, *e.g.*, a game application, is required for sending a message to a recipient. This is clear from Figure 3, where it is stated that to send a message, the Send Mail option needs to be selected to "route your captured files to a 32-bit MAPI client." It is further stated in Figure 3, in the "Tip" section, that "[t]he output will be directed to your mail program for handling." Further, in Figure 9, in reference to sending screen shots to someone using E-mail, it is stated that "if you need to send screen shots to someone or a group using E-mail <u>and your E-mail system is MAPI compliant</u> ...". (emphasis added) This clearly shows that SnagIt requires an external mail client. Moreover, in Figure 6, it is stated that "[f]or mail output, a 32-bit MAPI mail client (for example, Microsoft Exchange) <u>must be configured</u>." (emphasis added) Lastly, and perhaps most pertinent, in Figure 3 it is stated that "[t]he Send Mail output option is only supported if you have a 32-bit MAPI mail client installed (*e.g.*, Microsoft Exchange)." It is therefore very clear that SnagIt requires the use of an external mail client for sending messages including screenshots or other multimedia information that may have been captured from a game. It is, therefore, also very clear that SnagIt does not teach or suggest the limitations of sending, or instructions causing a processor to send, "the composite message <u>from within the game application to the intended recipient</u> over the network" as is recited in claims 1 and 19, respectively. (emphasis added)

In the Response to Arguments section of the Office Action dated February 9, 2004, the Examiner referred to the "Hotkey Combination" topic of SnagIt to show that "SnagIt does not require the user to exit the game application to activate the image capture procedure." (page 8) It was further stated that the "user invokes the SnagIt hotkey from within the game application" and "[w]hen the user is done with the image and the message (i.e., the message is dispatched), Snagit releases control of the system back to the game application automatically...". (page 8) It was also stated that a mail form for message information is displayed upon invocation of the hotkey.

Applicants agree that the hotkey combination as taught by SnagIt allows a user to activate an image capture process. However, Applicants respectfully disagree with the remaining characterization of SnagIt and the hotkey combination functionality as taught therein. First, as above, SnagIt does require the user to exit an application to send a message. The hotkey combination taught by SnagIt (see, e.g., Figure 7 of SnagIt) only teaches image capture functionality. A user may use a hotkey to capture an image during execution of an application. However, the hotkey has nothing to do with sending a message as alleged by the Examiner. That is, the hotkey combination of SnagIt neither teaches nor suggests sending a message or generating a mail form; the hotkey is only directed to capturing an image and making it available as a file that may be processed by, for example, an external e-mail client. With reference to Figure 7 of Snagit, a user may reconfigure the combination of keys that operate as a capture activation combination. Similarly, point 5 in Figure 3 of SnagIt states to "[p]ress your hotkey combination to perform the capture." Thus, it is clear that the hotkey is used for image capture. However, nowhere in these Figures or elsewhere in SnagIt is there a teaching or suggestion of sending a message using a hotkey combination. One likely reason there is no such teaching or suggestion in SnagIt is that in order to send a message including a screenshot, the user must access the system's external MAPI e-mail client, as discussed above.

Applicants presented similar arguments as above in an Amendment after Final filed on April 7, 2004. Responsive thereto, the Examiner stated in an Advisory action mailed on May 3, 2004 that the "Request for reconsideration has been considered but does not place the application in condition for allowance because SnagIt anticipates the capture of multimedia information from a game, the generation of a message without leaving the game environment,

where the message includes the captured multimedia information, and the dispatch of the message to the intended recipient." The Examiner, however, failed to address or contest the arguments presented in the Amendment after Final as discussed above, namely that the reference the Examiner is relying on (SnagIt) did not itself support the allegations made by the Examiner.

Accordingly, it is respectfully submitted that SnagIt fails to teach or suggest the methods and computer readable medium product as recited in independent claims 1, 9 and 19. Therefore, it is respectfully submitted that these claims are allowable and that the anticipation rejection over SnagIt is improper.

Claims 2-4, 7, 10-13 and 21 depend, either directly or indirectly, on allowable claims 1, 9 and 19, and therefore they are allowable for at least the reasons claims 1, 9 and 19 are allowable.

II.   Rejections under 35 USC §103(a) over SnagIt in view of Snook, Killcommons *et al.*, or Toyoda.

Claims 5, 6, 16, 17 and 20

Claims 5, 6, 16, 17 and 20 are not obvious over SnagIt in view of Snook.

As above, SnagIt fails to teach or suggest limitations in independent claims 1, 9 and 19, from which these claims depend. Further, Snook fails to remedy the deficiencies of SnagIt. For example, Snook also fails to teach or suggest the limitation of sending the composite message from within the game application to the intended recipient over the network as recited in claim 1, and similar limitations in claims 9 and 19. Therefore, these claims are allowable based at least on their dependency from allowable claims 1, 9 and 19.

Claims 14 and 15

Claims 14 and 15 are not obvious over SnagIt in view of Killcommons *et al.*

As above, SnagIt fails to teach or suggest limitations in independent claim 9, from which these claims depend. Further, Killcommons *et al.* fails to remedy the deficiencies of SnagIt. For example, Killcommons *et al.* also fails to teach or suggest the limitation of sending the composite message from within the game application to a recipient at a remote location as

recited in claim 9. Therefore, these claims are allowable based at least on their dependency from allowable claim 9.

Claim 18

Claim 18 is not obvious over SnagIt in view of Toyoda

As above, SnagIt fails to teach or suggest limitations in independent claim 9, from which this claim depends. Further, Toyoda fails to remedy the deficiencies of SnagIt. For example, Toyoda also fails to teach or suggest the limitation of sending the composite message from within the game application to a recipient at a remote location as recited in claim 9. Therefore, this claim is allowable based at least on its dependency from allowable claim 9.

CLAIMS APPENDIX:

1   1.   (Previously Presented) A method of sending an electronic message from

2   within a game application to an intended recipient over a network, comprising:

3   receiving a user input selecting an image generated by the game application;

4   generating a message form from within the game application for receiving

5   message information;

6   combining the selected image and the message information into a composite

7   message; and

8   sending the composite message from within the game application to the intended

9   recipient over the network.

1   2.   (Original) The method of claim 1 wherein message information further

2   comprises address information for the recipient.

1   3.   (Original) The method of claim 1 wherein message information further

2   comprises message text to be transmitted to the recipient.

1   4.   (Original) The method of claim 1 further comprising:

2   receiving an address specifying a recipient of the message; and

3   attaching the address to the composite message; and wherein sending comprises

4   sending the composite message to the specified address.

1   5.   (Original) The method of claim 1 further comprising:

2   receiving a generate message command; and

3   responsive to receiving the generate message command, pausing execution of the

4   application.

1   6.   (Original) The method of claim 5 further comprising:

2   responsive to a message containing the image being transmitted, resuming

3   execution of the application.

1   7.   (Original) The method of claim 1 further comprising:

2   sending a message containing recipient and sender data to a predetermined

3   recipient to allow the predetermined recipient to identify potential users of the application.

1   8.   (Canceled)

1   9.   (Previously Presented) A method of capturing a gaming experience of a

2   currently executing game application for transmission as a message to a remote recipient:

3   capturing a user selected multimedia information generated as part of the gaming

4   experience;

5   receiving text to accompany the multimedia information;

6   creating a composite message using the captured multimedia information and the

7   received text; and

8   sending the composite message from within the game application to a recipient at

9   a remote location.

1   10.   (Original) The method of claim 9 wherein capturing user selected

2   multimedia information comprises

3   capturing an image currently being displayed by the application.

1   11.   (Original) The method of claim 9 wherein capturing the user selected

2   multimedia information comprises:

3   retrieving an audio file linked to the application.

1   12.   (Previously Presented) The method of claim 10 wherein capturing an

2   image further comprises:

3   removing extraneous information from the currently displayed image.

1   13.   (Previously Presented) The method of claim 10 wherein capturing an

2   image further comprises:

3   scaling the currently displayed image to a smaller size.

1   14.   (Original) The method of claim 9 wherein sending the composite message

2   comprises:

3   compressing the multimedia information.

1   15.   (Original) The method of claim 14 wherein sending further comprises:

2   converting the composite message into a format compatible with an electronic

3   messaging protocol.

1   16.   (Original) The method of claim 9 further comprising:

2   pausing execution of the application responsive to receiving a selection of

3   multimedia information.

1   17.   (Original) The method of claim 16 further comprising:

2   resuming execution of the application responsive to sending the composite

3   message.

1   18.   (Original) The method of claim 9 further comprising:

2   displaying a notification to the sender that the sent message has been received.

1   19.   (Previously Presented) A computer readable medium for sending an

2   electronic message from within a game application to an intended recipient over a network, the

3   computer readable medium storing instructions for causing a processor to:

4   receive a user input selecting an image displayed by the game application;

5   generate a message form from within the game application for receiving message

6   information;

7   combine the selected image and the message information into a composite

8   message; and

9   send the composite message from within the game application to the intended

10   recipient over the network.

1   20.   (Original) The computer readable medium of claim 19 storing instructions

2   that further cause the processor to:

3   pause execution of the application responsive to receiving a generate message

4   command; and

5   responsive to a message containing the image being transmitted, resume

6   execution of the application.

1   21.   (Previously Presented) The computer readable medium of claim 18

2   wherein the instructions to receive user input selecting an image further cause the processor to:

3   remove extraneous information from the displayed image.

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EVIDENCE APPENDIX:

None

RELATED PROCEEDINGS APPENDIX:

None

Appellant respectfully requests consideration of this Supplemental Appeal Brief, and also of Appellant's Reply Brief filed May 5, 2005 in response to the Examiner's Answer mailed March 7, 2005.

Please deduct any requisite fees, pursuant to 37 CFR § 1.17(c) and/or 37 CFR §§ 1.136(a) or 1.136(b) from deposit account 20-1430 and any additional fees associated with this Supplemental Appeal Brief.

Respectfully submitted,
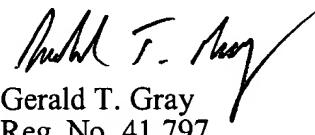
Gerald T. Gray
Reg. No. 41,797

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 925-472-5000
Fax: 415-576-0300
GTG:sea
60802898 v1